

## **REMARKS**

### **A. BACKGROUND**

The present Amendment is in response to the Office Action mailed 16 August 2010. Claims 3-7 and 28-35 were pending and rejected in view of cited art. Claims 3 and 29 are amended. Claims 3-7 and 28-35 remain pending in view of the above amendments, with claims 3 and 29 being independent.

Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicant's remarks are presented in the order in which the corresponding issues were raised in the Office Action.

Please note that the following remarks are not intended to be an exhaustive enumeration of the distinctions between any cited references and the claimed invention. Rather, the distinctions identified and discussed below are presented solely by way of example to illustrate some of the differences between the claimed invention and the cited references. In addition, Applicant requests that the Examiner carefully review any references discussed below to ensure that Applicant's understanding and discussion of the references, if any, are consistent with the Examiner's understanding.

### **B. EXAMINER'S INTERVIEW**

Applicant's express their appreciation to the Examiner for conducting an interview with Applicant's representative on September 22, 2010. The substance of the interview is included in this response.

### **C. PRIOR ART REJECTIONS**

#### **I. REJECTION UNDER 35 U.S.C. § 103**

The Office Action rejected claims 3-7 and 28 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,059,201 (*Asnsi*) in view of U.S. Patent No. 6,090,063 (*Makower et al.*), while claims 29-35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Asnsi* in view of *Makower et al.* and U.S. Patent No. 5,462,562 (*Elkus*). Applicant respectfully submits that the independent claims as presented for reconsideration are not anticipated nor made obvious by *Asnsi*, *Makower et al.*, or *Elkus*, either singly or in combination with any other cited reference of record.<sup>1</sup>

---

<sup>1</sup> Any amendments to claims other than those which are expressly relied upon in overcoming the rejections on art have been made simply to insure consistency in claim language, to correct typographical or grammatical errors, or to

In particular, *Asnsi* discloses "[a] surgical instrument for threading a loop of suture material through a piece of tissue to be stitched" (Abstract). The Office Action indicates that "Asnis does not expressly disclose the opening of the shaft being formed in a side in close proximity to the distal end of the shaft and formed proximal to the groove, and the groove communicating with the shaft lumen distal to the opening, the groove in communication with both the lumen and the side opening" (Office Action, p. 4). To overcome this deficiency the Office Action cites *Makower et al.*, which discloses "device, system and method for implantation of filaments and particles in the body" (Title). In particular, FIGS 27A-30D illustrated various proximate regions of a filament carrying cannula that include outer and inner members 212 and 213 which move relative to one another to cut the suture. (see col. 16, ln. 58-col. 17. ln. 18 as exemplary).

That said, no mention is made of the device of *Makower et al.* including a shaft "having a wall defining a lumen . . . the shaft having an opening formed through the wall and in a side thereof in close proximity to the distal end of the shaft and a groove formed through the wall of the shaft and extending from the distal end of the lumen toward the proximal end and communicating with the lumen distal the opening along the length of the groove, the groove also being in communication with the opening formed in the wall and in the side of the shaft, the opening being in communication with the lumen and being disposed proximal the distal end of the shaft and the groove and distal the proximal end of the shaft, and includes a proximal edge" as recited in independent claim 3. Similarly, no mention is made of the device having a shaft including "a bore defined by a wall of the shaft . . . the shaft having an opening formed in and through the wall of the shaft in close proximity to the distal end of the shaft and a groove formed through the wall of the shaft and extending from the distal end of the lumen toward the proximal end and being in communication with the bore distal the opening along the length of the groove, the groove also being in communication with the opening formed in the side and wall of the shaft, the opening being in communication with the bore, and being disposed proximal the distal end of the shaft and the groove and distal the proximal end of the shaft" as recited, in part, in independent claim 29.

Accordingly, for at least the reasons noted, independent claims 3 and 29 and the claims depending therefrom<sup>2</sup> are neither anticipated nor made obvious by *Asnsi* or *Makower et al.*, either singly or in combination with any other prior art of record<sup>3</sup>, and thus reconsideration and withdrawal of the rejection is respectfully requested.

**D. CONCLUSION**

In view of the foregoing, and consistent with the discussion during the Examiner Interview, Applicant respectfully submits that the other rejections to the claims are now moot and do not, therefore, need to be addressed individually at this time. It will be appreciated, however, that this should not be construed as Applicant acquiescing to any of the purported teachings or assertions made in the last action regarding the cited art or the pending application, including any official notice. Instead, Applicant reserves the right to challenge any of the purported teachings or assertions made in the last action at any appropriate time in the future, should the need arise. Furthermore, to the extent that the Examiner has relied on any Official Notice, explicitly or implicitly, Applicant specifically requests that the Examiner provide references supporting the teachings officially noticed, as well as provide the required motivation or suggestion to combine references with the other art of record.

For at least the foregoing reasons, Applicant respectfully submits that the pending claims are neither anticipated by nor made obvious by the art of record. In the event that the Examiner finds any remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

---

<sup>2</sup> Emphasis herein of the differences between the independent claims and the prior art are equally applicable to the dependent claims 4-7, 28, 30-35, but this does not mean, on the other hand, that these are necessarily the *only* differences between the claimed invention and the prior art of record. Applicants thus do not acquiesce in any asserted rejections of the dependent claims 4-7, 28, 30-35.

<sup>3</sup> *Elkus* was cited as a secondary reference. *Elkus* was cited for the proposition that it discloses "a suture passer with a fitting 13 fixed within a bore of a shaft 10" (Office Action, p. 7). That said, *Elkus* does not otherwise add anything in terms of reading on the claims as amended herein, particularly in reference to those claimed limitations noted above which clearly define over *Asnis* or *Makower et al.* Thus, even assuming *arguendo* that *Elkus* is properly combinable with *Asnis* and/or *Makower et al.*, such combinations are clearly distinguished by the claims for the reasons already noted in reference to *Asnis* or *Makower et al.*

Application No. 10/027,681  
Amendment "L" dated November 16, 2010  
Reply to Office Action mailed August 16, 2010

Dated this 16<sup>th</sup> day of November, 2010.

Respectfully submitted,

/Paul N. Taylor, Reg.# 57271/

PAUL N. TAYLOR

Registration No. 57,271

Attorney for Applicant

Customer No. 57360

Telephone No. 801.533.9800

FDR: PNT: kdj  
1507302\_1.DOC